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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/560,228	12/12/2005	Hiroshi Ono	053460	2690

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EXAMINER

MARCHESCHI, MICHAEL A

ART UNIT PAPER NUMBER

1793

MAIL DATE DELIVERY MODE

02/06/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/560,228	Applicant(s) ONO ET AL.	
	Examiner Michael A. Marcheschi	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 2,3,6 and 14-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,5 and 7-13 is/are rejected.
- 7) ☒ Claim(s) 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/12/05, 2/2/07</u> . | 6) <input type="checkbox"/> Other: _____ |

Applicant's election without traverse of Group I, claims 1, 4, 5 and 7-13 in the reply filed on 1/2/08 is acknowledged.

Claims 4, 5 and 7-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4, 5 and 7-13 are indefinite because they depend on withdrawn claims.

Claim 7 is also indefinite because the limitation "the compound having the triazole skeleton having no amino group" lacks antecedent basis because this compound has not been literally defined in claim 1

Claim 13 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The films to be polished do not further limit the slurry in terms of its compositional background.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4, 5 and 7-13 are rejected under 35 U.S.C. 103(a) as being obvious over Uchida et al. (630) in view of Sameshima et al. (624).

Uchida et al. teaches a composition comprising (1) an oxidizer (claimed material), (2) an organic acid, (3) water soluble polymer (claimed material), (4) a protective film forming agent (i.e. mixture of 1,2,3-triazole and 3-amino-1,2,4-triazole) for forming a protective film on the metal (copper) surface, (5) an abrasive and (6) water. See abstract and sections [0014]-[0017], [0041]-[0050]. This reference is silent as to the imidazole.

Sameshima et al. teaches in sections [0032]-[0034] that 4-methylimidazole is a well known protective film forming agent for copper.

With respect to the use of 4-methylimidazole in combination with the protective film forming agents of Uchida et al., the use of a mixture would have been obvious because, it is prima facie obvious to combine two or more materials disclosed by the prior art to form a third

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material (combination of protective film forming agent) that is to be used for the same purpose.

In re Kerkhoven 205 USPQ 1069.

Claims 1, 7-11 and 13 are rejected under 35 U.S.C. 102(a) as being anticipated by EP 1260607.

The EP reference teaches in sections [0022]-[0028], a composition comprising (1) a mixture of benzotriazole, imidazole (i.e. methylimidazole) and aminobenzotriazole (or other triazole having amino groups), (2) nitric acid (oxidizer), (3) polycarboxylic acid as a chelating agent, (4) other organic acids and (5) water.

The claimed invention is anticipated by the reference because said reference teaches a composition that contains all of the claimed components.

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being obvious EP 1260607 in view of Uchida et al. (630) and/or Sameshima et al. (624).

Although the EP reference does not literally define the exact claimed material of instant claim 4, the reference does state that the triazole can have amino groups, thus the skilled artisan would have been clearly appreciated and found obvious that 3-amino 1,2,4 triazole would fall into this category because this is a well known triazole with amino groups as is clearly shown by Uchida et al.

Although the EP reference does not literally define the exact claimed material of instant claim 5, the reference does state that methylimidazole can be used, thus the skilled artisan would

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have been clearly appreciated and found obvious that 4-methylimidazole would fall into this category because this is a well known methylimidazole as is clearly shown by Sameshima et al.

Claims 1, 4, 5 and 7-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Kurata et al. (609).

Kurata et al. teaches in sections [0019]-[0039], a composition comprising (1) a mixture of 1,2,3 triazole, an imidazole (claimed materials) and the claimed amino triazole, (2) an oxidizer (claimed materials), (3) water soluble polymers, (4) organic acids, (5) abrasives and (6) water.

The claimed invention is anticipated by the reference because said reference teaches a composition that contains all of the claimed components.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this

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rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Claims 1, 4, 5 and 7-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Kurata et al. (669).

Kurata et al. teaches in sections [0034]-[0053], a composition comprising (1) a mixture of 1,2,3 triazole, an imidazole (claimed materials) and the claimed amino triazole, (2) an oxidizer (claimed materials), (3) water soluble polymers, (4) organic acids, (5) abrasives and (6) water.

The claimed invention is anticipated by the reference because said reference teaches a composition that contains all of the claimed components.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in

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accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 4, 5 and 7-13 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 10/517,049. Although the conflicting claims are not identical, they are not patentably distinct from each other because the reduction to practice of the copending claims

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would render obvious the instant claims. The claims define all of the claimed limitation with the exception of the specific inhibitor compounds used, however, claim 5 defines the inhibitors that can be used and one can look to the specification as a definition of what inhibitors are included in these groups.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1, 4, 5 and 7-13 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of copending Application No. 10/513,002. Although the conflicting claims are not identical, they are not patentably distinct from each other because the reduction to practice of the copending claims would render obvious the instant claims. The claims define all of the claimed limitation with the exception of the specific inhibitor compounds used, however, claim 5 defines the inhibitors that can be used and one can look to the specification as a definition of what inhibitors are included in these groups.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The additional references cited on the 1449 have been reviewed by the examiner and are considered to be art of interest since they are cumulative to or less than the art relied upon in the above rejections.

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Any foreign language documents submitted by applicant has been considered to the extent of the short explanation of significance, English abstract or English equivalent, if appropriate.

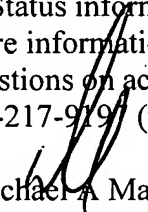
Since (1) a short explanation of significance, (2) an English abstract or (3) an English equivalent, if appropriate, of foreign document DE 199 26 117 A1 has not been supplied with the IDS, this document has not been considered.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Marcheschi whose telephone number is (571) 272-1374. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

2/08
MM


Michael A. Marcheschi
Primary Examiner
Art Unit 1793